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REMARKS

The Examiner has acknowledged that the information disclosure statement (IDS) submitted on June 7, 2004 is being considered. However, applicant submitted two (2) IDS's on the same date, one of which identified related applications.

Applicant hereby requests consideration of such related application IDS. See MPEP 609(C) and 609D.

The Examiner has rejected Claims 1-19 under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims have been amended to clarify what is being claimed, thus rendering such rejection moot.

The Examiner has rejected Claims 1-17 and 19 under 35 U.S.C. 101 because the claimed invention is allegedly directed to non-statutory subject matter. The claims have been amended to clarify what is being claimed, thus rendering such rejection moot.

The Examiner has further rejected Claims 1-19 under 35 U.S.C 102(e) as being anticipated by Rivette et al. (US 2003/0046307). Applicant respectfully disagrees with such rejection, especially in view of the amendments made hereinabove. Specifically, each of the independent claims have been amended to include, at least in part, the subject matter of Claims 14-17, as well as additional limitations believed to be novel, when taken in combination with the remaining limitations.

First, it appears that the excerpts from Rivette relied upon by the Examiner are deficient in numerous respects. For example, the Examiner relies on the following excerpts from Rivette to make a prior art showing of applicant's claimed "associating a plurality of patents with the at least one identifier" (see this or similar, but not identical, language in each of the independent claims, as amended).

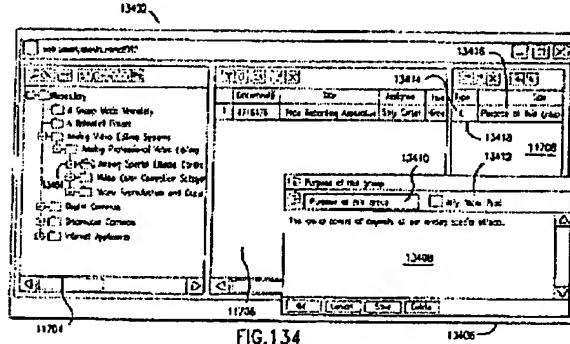
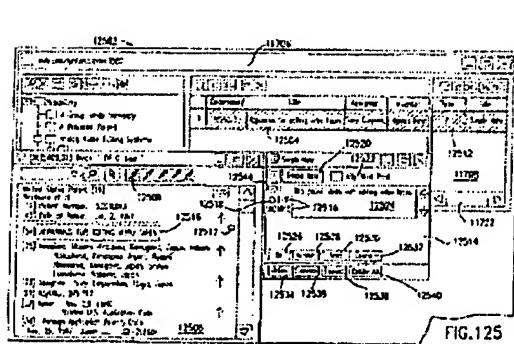
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"[0384] Notes may have attributes, such as (but not limited to) the person who created the notes (relevant for security purposes), the date the note was created, the data format(s) of data stored in the note (text, image, graphics, video, audio, spreadsheet, database, etc.), the note title, the note subject, whether the note contains information that would be considered to be Attorney/Client privileged or confidential, and the date the note was last modified.

[0385] According to an embodiment of the invention, notes are hierarchically organized. That is, a given note may be a child note of any number of parent notes, and may have any number of child notes. This, of course, is in addition to the linkage of notes to portions of documents. This hierarchical organization may be implemented by having in the note databases 640 a note\_note\_xref table, that would be similar to the group\_group\_xref table 1229. The note\_note\_xref table would have a parent note attribute storing the note ID of the parent note, and a child note attribute storing the note ID of the child note."

After a careful review of such excerpt, however, it is clear that there is not even a suggestion, in such excerpt, of any sort of association of patents with at least one identifier, as claimed, in combination with the remaining claim elements (as amended).

Further, the Examiner relies on the following figures from Rivette to make a prior art showing of applicant's claimed "allowing the manual selection of a file; storing the manually selected file in association with the at least one identifier" (see this or similar, but not identical, language in each of the independent claims, as amended).



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Applicant respectfully disagrees with the reliance on such excerpts. Specifically, the foregoing excerpts merely address entering notes. See, for example, the following related exemplary description from paragraph 1201 from Rivette, which describes the related feature.

"In the New Group window 13406, the user can enter the title of the group note in field 13410, and can enter information for the group note in field 13408. The operator can also indicate whether the group note constitutes attorney work product by checking field 13412."

Such excerpt and the figures cited by the Examiner merely suggest the manual entry of notes, not the "manual selection of a file [for] storing the manually selected file in association with the at least one identifier." Applicant teaches and claims a technique for allowing a user to manually select a file so that it may be associated with at least one identifier (which is, in turn, associated with a plurality of patents, as claimed, in combination with the remaining claim elements, as amended). Such feature (when claimed in combination with the remaining claim elements, as amended) offers numerous optional advantages (which render such feature unobvious), as will soon become apparent.

Even still, the Examiner further relies on the foregoing excerpts from Rivette to make a prior art showing of applicant's claimed "wherein the manually entered notes, at least one of the manually selected files ... are accessible by subsequent selection of the at least one identifier" (see this or similar, but not identical, language in each of the independent claims, as amended). Applicant respectfully disagrees with the Examiner's reliance on the foregoing excerpts. Since the foregoing excerpts from Rivette do not even suggest associating a manually selected file with an identifier, there can simply be no accessing such manually selected file by the selection of the identifier, in such excerpts.

Despite the foregoing paramount deficiencies in the Rivette excerpts relied upon by the Examiner and in the spirit of expediting the prosecution of the present application, applicant has amended each of the independent claims to include the

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following or similar, but not identical, subject matter, to ensure that Rivette is clearly distinguished:

“wherein a manually selected first file is capable of being associated with a first identifier corresponding to a single patent, and a manually selected second file is capable of being associated with a second identifier corresponding to a group involving a plurality of patents”; and

“wherein the notes and at least one of the files are made accessible to other parties utilizing e-mail”.

Such features, when taken in combination with the remaining claim elements, offer numerous optional advantages (which render such feature unobvious), such as allowing a user to retrieve a manually-selected file for review in conjunction with at least one identifier (in an environment, where multiple identifiers exist: at least one associated with a single patent and at least one associated with multiple patents), when desired. Moreover, both the notes and at least one of the files are made accessible to other parties utilizing e-mail, thus enabling convenient sharing of a specific file and notes associated with at least one identifier.

Thus, a user may wish to manually select web pages, articles, spreadsheets, slide shows, compressed documents such as files in Portable Document Format (.pdf), multimedia files, and/or streaming multimedia, etc., and associate the same with at least one identifier, as claimed, without having to try to manually enter the same via a notes field. Depending on the scope of relevance of such files, the same may be associated with either a first identifier corresponding to a single patent, and/or a second identifier corresponding to a group involving a plurality of patents. To this end, files may be associated with such different identifiers and at least one of the files may further be shared with other parties utilizing e-mail. Only applicant teaches and claims the framework for providing such additional techniques.

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Still yet, in the further spirit of expediting the prosecution of the present application, applicant has even still amended each of the independent claims to include, at least in part, the subject matter of Claims 14-17, as well as additional limitations, to ensure that Rivette is clearly distinguished.

In the latest action, the Examiner rejects the subject matter of former Claims 14-17 based on the following excerpts from Rivette: Fig. 2, Fig. 29, Fig. 157, paragraphs 0025-0026, 0261-0262, 0258, 0264, 0266-268, 0273, 0346, etc. After carefully reviewing such excerpts, along with the remaining Rivette reference, however, applicant is forced to respectfully disagree with the Examiner's assertion. Specifically, there is not even a suggestion of any sort of "technology mapping," as claimed by applicant. Only applicant teaches and claims the association of notes and files with the specifically claimed identifiers, where further technology mapping-related information may be obtained with respect to a set of patents.

Applicant further argues that many benefits arise from the synergy of the formerly claimed framework and the now-claimed technology mapping. Specifically, a user is capable of associating patents with at least one identifier (with additional notes and at least one file associated therewith), and also obtaining technology-related metrics regarding a set of patents, with one framework.

To further emphasize the features of the technology mapping, applicant now claims (in each of the independent claims, in combination with the remaining elements), the following subject matter:

"wherein a set of patents is capable of being reported by:  
displaying a technology mapping depicting at least one category of technology utilizing a graphical user interface,  
displaying statistics regarding a number of the patents of the set in each category of technology,  
displaying first additional information associated with at least a portion of the patents of the set upon the selection of an icon,

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wherein the first additional information includes a list of the patents of the set associated with one category of technology,

displaying second additional information associated with at least one of the patents of the list upon the selection of an additional icon, wherein the second additional information is selected from the group consisting of a patent number, a status, an exemplary claim, and an exemplary figure,

wherein the statistics are displayed in a first interface, the first additional information is displayed in a second interface separate from the first interface, and the second additional information is displayed in a third interface separate from the first interface and the second interface."

Only applicant teaches and claims such a drill-down technique for accessing information relating to the patents subject to the technology mapping, which is believed to be unique, when taken in combination with the remaining claim elements.

The Examiner is reminded that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, the identical invention must be shown in as complete detail as contained in the claim. *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236, 9USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

This criterion has simply not been met by the Rivette reference, especially in view of the amendments made hereinabove. A notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Applicant further argues that the Examiner's rejection is deficient with respect to many additional claims. Just by way of example, the Examiner relies on

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Figs. 4, 6, 117-118, 153, 157, 164, 171, 179-184; and paragraphs 0026, 0211, 0376 to make a prior art showing of applicant's claimed "wherein the file is selected utilizing a file structure field including a file tree-structure that allows a user to browse various folders where files have been previously stored, where the file structure is displayed simultaneously with the notes field on the same interface" (see dependent Claims 8-11, and independent Claims 19 and 20).

After carefully reviewing the foregoing excerpts and the remaining Rivette reference, however, applicant respectfully disagrees with the Examiner's assertion. Again, since Rivette does not even suggest associating manually selected files with identifiers, as specifically claimed (in combination with the remaining claim elements), there can simply be no disclosure, teaching or suggestion of applicant's claimed features of Claims 8-11, 19 and 20, which enhance the manual file selection.

For example, Rivette merely suggests a file tree-structure for organizing groups of patents already associated with an identifier, not for browsing folders to manually select a file therein, for the specific purpose of associating such file with an identifier (which corresponds to a plurality of patents).

To further distinguish these features, independent Claims 19 and 20 now emphasize that "the file selected utilizing the file tree-structure includ[es] information from a source separate from the patents." Only applicant teaches and claims a technique for associating manually selected files from a source separate from patents with at least one identifier, where such files are gathered utilizing a file tree-structure and convenient single interface that allows simultaneous entry/selection of notes/files.

Again, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

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Still yet, applicant has amended/added various claims which still further distinguish the Rivette reference. For example, applicant now claims, in independent Claim 21, a technique where "a search is capable of being performed in associated with at least one of the patents using with at least one synonyms, by: identifying at least one claim associated with one of the patents, extracting a plurality of terms from the claim, identifying at least one synonym associated with at least one of the terms, and conducting a search utilizing the terms and the at least one synonym." Only applicant teaches and claims such a combination of features for improving searching capabilities.

Even still, applicant brings the following subject matter in new Claims 22-43 to the Examiner's attention:

"wherein the statistics are represented via at least one bar graph" (see Claim 22);

"wherein the second additional information includes a patent number, a status, an exemplary claim, and an exemplary figure" (see Claim 23);

"wherein the patents are associated with one particular corporate entity" (see Claim 24);

"wherein the patents are associated manually" (see Claim 25);

"wherein the patents are manually entered via a registration interface" (see Claim 26);

"wherein the patents are extracted from a database including a comprehensive set of intellectual property identifiers associated with at least one governmental authority" (see Claim 27);

"wherein the terms of the claim are automatically retrieved from a database" (see Claim 28);

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“wherein noun terms of the claim are identified” (see Claim 29);

“wherein verb terms of the claim are identified” (see Claim 30);

“wherein Boolean searching is incorporated with the searching based on the terms of the claim of the patent and the at least synonym” (see Claim 31);

“wherein AND operators are incorporated with the terms of the claim of the patent and the at least synonym” (see Claim 32);

“wherein a plurality of the synonyms are identified based on the terms of the claim of the patent, utilizing a synonym database” (see Claim 33);

“wherein the synonyms are incorporated with the terms of the claim of the patent to increase the breadth of the search” (see Claim 34);

“wherein the synonyms are incorporated with the terms of the claim of the patent utilizing an OR operator” (see Claim 35);

“wherein the word “claim” is removed from the terms of the claim of the patent” (see Claim 36);

“wherein the search is conducted manually upon receiving a user request” (see Claim 37);

“wherein the search is conducted automatically at predetermined intervals” (see Claim 38);

“wherein the terms are modified based on results of the search” (see Claim 39);

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“wherein the terms are modified based on results of the search and user input” (see Claim 40);

“wherein the terms are modified based on results of the search automatically” (see Claim 41);

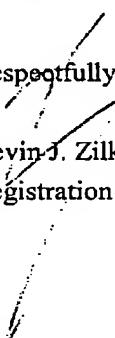
“wherein the at least one identifier includes a patent identifier” (see Claim 42); and

“wherein the at least one identifier includes a technology identifier” (see Claim 43).

Yet again, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. For payment of any fees due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1351 (Order No. SVIPGP002B).

Respectfully submitted,

  
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